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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/099,977	03/19/2002	Francis Emmerson	367.41233X00	5510
20457	7590	01/03/2005	EXAMINER	
ANTONELLI, TERRY, STOUT & KRAUS, LLP 1300 NORTH SEVENTEENTH STREET SUITE 1800 ARLINGTON, VA 22209-9889			BAYERL, RAYMOND J	
			ART UNIT	PAPER NUMBER
			2173	

DATE MAILED: 01/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/099,977	Applicant(s) EMMERSON ET AL.	
	Examiner Raymond J. Bayerl	Art Unit 2173	

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 12 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 - 12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>19 March 2002</u> | 6) <input type="checkbox"/> Other: ____ |

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1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

"CLIENT-SERVER SYSTEM" is descriptive of an exceedingly broad area of technology, when the invention is more particularly directed to the authenticated downloading of content to a radio communication device

2. The disclosure is further objected to because there is no mention made of drawing figure 5.

Appropriate correction is required.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 3, 4, 10 – 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

When claims 3, 4 recite "A system or terminal as defined in claim 1", it is not clear how such a claim can properly be expressed as a dependent of claim 1, which is directed instead to "A client-server system". A similar problem exists in "A system or terminal as defined in claim 2" (claims 10, 11)—claim 2 is instead "A client terminal".

Also as per claim 11, it is noted that this is verbatim the same claim as claim 10. Why does applicant have two identical claims dependent upon parent claim 2?

As per claim 12, its further limitation to claim 3 is precisely the same as claim 3's limitation to claim 1, also making it unclear why applicant has presented such a claim.

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5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

6. Claim 6 is rejected under 35 U.S.C. 102(a) as being anticipated by Roke Manor Research Limited ("Roke Manor"; GB #2 349 548 A).

This independent claim, directed to a "computer program product on a portable radio communication device", is sufficiently broad to read upon Roke Manor's Downloading software to mobile telecommunication users. As seen in fig 1, network subscribers 16 using a variety of mobile communication devices such as mobile phone or PDAs are permitted to contact a network operator 12 via a base station (see page 4, paragraphs 1, 2), so that software is sent to the subscriber site. Then, "content downloaded from a server to the device" is made subject to "security checking", by mean of an authentication code which enables the Java™ class software to run. In receiving this authentication code, the Roke Manor "device" can "determine whether or not the downloaded content is from a trusted server", since only such a "trusted server" would have this level of authentication in place.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1 – 5, 7 – 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roke Manor in view of Red Fig Limited (“Red Fig”; GB #2 344 491 A).

As per independent claim 1’s “client-server system” (see also independent claim 2), it has been noted above that Roke Manor disclose a “client terminal” in the form of a “portable radio communication device” and “authentication means...for checking validation data of content downloaded from the server”. Roke Manor further teaches the use of “menu applications” that provide “a user selectable direct download link”, in the form of a list that may appear in a menu type format (page 5, paragraph 3). Once the Roke Manor subscriber 16 has made a selection, it is properly enabled by the authentication code, which permits the “client terminal” to know that the “user” is properly established in accepting and running the software that has been “downloaded” as “content” from the “server”.

Roke Manor, while identically disclosing the use of a Java™ platform for retrieved software, does not **xplicitly** teach that a “browser application controls the

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radio communication device to transmit a signal to connect to the server". However, Red Fig specifically discloses Browsing the Internet using a mobile telephone, so as to obtain Variable data for HTML pages, accessed via a URL (Abstract). A server process 30 in Red Fig (see pages 7 – 8; fig 2) responds to the URL.

Thus, it would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to operate the user-selectable interface for software retrieval found in Roke Manor via Red Fig's "browser", so that the standard formats of both HTML and Java would have a well-understood channel by which to pass, in obtaining "content" at a "radio communication"-linked site.

When Roke Manor has acquired, authenticated, and installed the software obtained by a subscriber, "storing the downloaded content to a memory of the terminal" takes place, as "default" (claims 3, 10 - 12).

In the combination of Roke Manor and Red Fig, a "download transport protocol" of "HTTP" is used (as in Red Fig), and Roke Manor's authentication code reads upon the claimed "header" (claim 4).

Independent claim 5 (see also independent claim 8) contains limitations generally found in independent claims 1, 2 as noted above, including "menu applications" and "a user selectable direct download link" (Roke Manor), along with a "browser application" that "controls the radio communication device to transmit a signal to connect to the server" (Red Fig).

Independent claim 7 is rejected for a similar line of reasoning to that developed for claim 5, with its "security checking" further reading upon Roke Manor's

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authentication code. This ability to "determine whether or not the downloaded content is from a trusted server" (independent claim 9) has been treated with respect to claim 6 above—in authenticating at the receiving end the user's entitlement to operate the software, Roke Manor is also allowing the "client terminal" to verify that the sender is indeed the one intended.


10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The US Patent documents additionally cited (see attached form PTO-892) relate to applicant's topic of providing downloads of assorted information types to a client device.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond J. Bayerl whose telephone number is (571) 272-4045. The examiner can normally be reached on M - F from 9:00 AM to 4:00 PM ET.

12. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca, can be reached on (571) 272-4048 thereafter. All patent application related correspondence transmitted by FAX **must be directed** to the central FAX number (703) 872-9306.

13. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.


RAYMOND J. BAYERL
PRIMARY EXAMINER
ART UNIT 2173

21 December 2004